

U.S.S.N. 09/997,402

### REMARKS – General

#### *Claim Rejections under 35 USC §103:*

The most recent Office Action (OA) rejects claims 1-20, 22-23, 35-36, 39-41, 43-51, 55-56, 60-71 and 73 under 35 USC §103 as being unpatentable over Jiang et al., US Pat. No. 6,741,853, hereinafter “Jiang”, in view of Tso et al., US Pat. No. 6,088,803, hereinafter “Tso”. Specifically, the OA submits that Jiang discloses “...selecting the content from the group consisting of locally stored applications, remotely stored, trusted applications, and remotely stored, untrusted applications ... and determining whether the content contains designated API.” The OA acknowledges that Jiang fails to teach provisioning the content for the target device, wherein when the content is selected from the remotely stored, untrusted applications, the provisioning comprises intercepting the content and inspecting the content, wherein the inspecting comprises at least one of examining the content to detect malicious code, and determining whether the content contains banned code.

The OA states that Tso teaches provisioning the content for a target device “...wherein when the content is selected from the remotely stored, untrusted applications, the provisioning comprises intercepting the content and inspecting the content, wherein the inspecting comprises at least one of examining the content to detect malicious code, and determining whether the content contains banned code.” The OA states that it would have been obvious to one of ordinary skill in the art at the time Applicants’ invention was made to combine Tso and Jiang to achieve Applicants’ invention. Applicants respectfully traverse this rejection.

Applicants respectfully submit that there is no motivation found in the references themselves to combine Jiang with Tso. In making the traversal, Applicants rely on MPEP §2143, citing *In re Fine*, which states that “...[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is *some teaching, suggestion, or motivation to do so* ...” *In re Fine*, 837 F.2d 1071. Emphasis added. Applicants respectfully submit that there is no suggestion in the references to combine a system for scanning applications to be delivered to personal

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computers for viruses, as is taught by Tso, with a system for reformatting data to be compatible with a particular type of mobile device, as is recited by Jiang.

To begin, the fields of invention are expressly distinct. Jiang's field of invention relates to "...wireless communications and ... device-dependent delivery of data to a wireless device", while Tso's field of invention relates to "...personal computers ...and... virus checking content to be downloaded to a network client." Applicants respectfully submit that neither the specification of Tso nor the specification of Jiang suggests that these distinct fields should overlap. Stated differently, there is no suggestion that wireless devices should be substituted for personal computers, and vice versa.

Courts have held that "Most, if not all, inventions arise from a combination of old elements." *See In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed.Cir. 1998). "Therefore an examiner may often find every element of a claimed invention in the prior art." *Rouffet* at 1457. "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'" *Rouffet*, citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2D (BNA) 1551, 1554 (Fed. Cir. 1996).

In light of the citations above, Applicants respectfully submit that there is no teaching in either Jiang or Tso to combine a system for scanning personal computer based applications with a system for reformatting mobile device applications. Specifically, Jiang makes no reference to malicious, banned or otherwise dangerous code. Further, Jiang makes no reference to the need to any interception and screening prior to delivery. In fact, Jiang Applicants fails to find any inclusion of a discussion of problems relating to malicious or banned code being transferred to target devices. Jiang is directed solely to reformatting data for operation with a particular device. For example, Jiang talks of formatting various forms of data for delivery to different types of devices, including PDAs and mobile telephones.

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Similarly, Tso fails to teach any need for virus scanning data being transferred to wireless, mobile devices. Tso is directed to delivery of executable applications for personal computers. Applicants note that personal computers and mobile devices operate on different operating systems, with different processing circuitry and different applications. Viruses are often directed towards global operating systems capable of operation on a variety of computational platforms. Mobile devices, by contrast, generally operate on embedded, proprietary operating systems. Tso simply fails to make any suggestion that applications for mobile devices should be scanned for viruses with a system such as the one taught by Jiang.

Further, Tso fails to teach any selective application of interception and scanning data when flowing through a WPN (as taught by Jiang) en route to a mobile device. Applicants respectfully note that a mere identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See *Ruffett* at 1457. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. See *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ1125, 1127 (Fed. Cir. 1984). Here there is no such motivation, suggestion, or teaching. In light of these remarks, Applicants respectfully request reconsideration of the rejection.

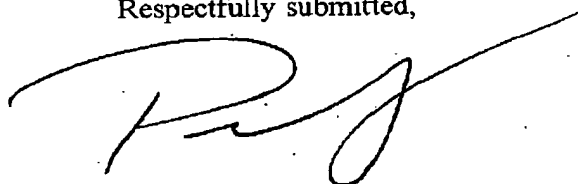
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**CONCLUSION**

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is now in condition for allowance, for which they respectfully submit. If any matter may be more easily handled by telephone, the undersigned attorney welcomes telephone calls from the Examiner.

Respectfully submitted,



Philip H. Burrus, IV

Attorney for Applicants

Registration No.: 45,432

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